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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF : James A. Savage and Paul A. Joyce

FOR : **SOFTWARE, APPARATUS, AND METHOD FOR
HAND-HELD ELECTRONIC DEVICES AND
ADVERTISING THEREON**

SERIAL NO. : 09/736,032

FILED : December 13, 2000

EXAMINER : Arthur Duran

ART UNIT : 3622

LAST OFFICE ACTION : July 6, 2005

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CERTIFICATE OF MAILING

I hereby certify that this **APPEAL BRIEF** is being deposited with the United States Postal Service on July 11th, 2005 in an envelope marked as "Express Mail Post Office to Addressee" service under 37 CFR 1.10 Mailing Label Number EV587 424 715 US addressed to: Mail Stop Appeal Brief- Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: D. M. Kempthorn
D. M. Kempthorn

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BRIEF OF APPELLANTS

Dear Sir:

This is an appeal from the final rejection of the Examiner mailed May 18, 2004, rejecting claims 1, 2, 4-8, 11, 12, 15, 16, 18, and 19. The Appellant's brief is accompanied by the required fee under Section 1.17(c). Following are the nine appeal brief items, under appropriate headings and in proper order, as required under 37 C.F.R. § 1.192(c).

I. REAL PARTY IN INTEREST

The real party in interest in this case is Digi Rx, LLC, and the inventors listed in the caption are owners of the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

No other appeal or interferences are known that would directly affect, be directly affected by, or have a bearing on the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS

This application is a Utility Patent application claiming priority from U.S. Provisional patent application, Serial No. 60/177,914, having a filing date of January 25, 2000. Zero (0) claims were filed for the U.S. Provisional patent application. Nineteen (19) claims were originally filed in the U.S. Utility patent application, S/N: 09/736,032, of which Claims 1, 2, 8, 12, and 16 are independent claims.

Applicant filed a preliminary amendment March 15, 2002. In the preliminary amendment claims 3, 9, 10, 13, 14, and 17 were cancelled. The Examiner has rejected the remaining claims 1, 2, 4-8, 11, 12, 15, 16, 18, and 19 in a final office action dated May 18, 2004.

In the Utility application, applicant submitted a preliminary amendment on March 15, 2002, canceling claims 3, 9, 10, 13, 14, and 17, and amending claims 2, 4, 8, 11, 12, 16, and 18. The Examiner rejected the thirteen (13) remaining claims 1, 2, 4-8, 11, 12, 15, 16, 18, and 19, in a first Office Action, dated December 16, 2003. In response thereto dated April 16, 2004, applicant further amended claim 5. The examiner subsequently rejected the pending claims 1, 2, 4-8, 11, 12, 15, 16, 18, and 19, in a final Office Action, dated May 18, 2004. Responsive to the aforementioned final Office Action, applicant filed a Notice of Appeal on January 18, 2005, to which the subject Appeal Brief pertains. Applicant notes that the aforementioned application was unintentionally abandoned by Applicant. Accordingly, Applicant filed a petition to revive along with the Notice of Appeal indicated above. The petition was granted February 11, 2005.

Allowed claims: None;

Claims objected to: None;

Claims cancelled: 3, 9, 10, 13, 14, and 17

Claims rejected: 1, 2, 4-8, 11, 12, 15, 16, 18, and 19.

IV. STATUS OF AMENDMENTS

Currently, Claims 1, 2, 4-8, 11, 12, 15, 16, 18, and 19 of the subject application are rejected by the Examiner as stated in a final office action dated May 18, 2004. No amendments have been submitted subsequent to the final office action. Inasmuch, applicant believes the status of pending claims remains as listed above.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claims 1 and 2

This invention relates to the art of advertising on hand held prescription writers as discussed on page 1 of the subject application, lines 21-25. The hand held device includes a central processing unit, random access memory, a viewing screen, a mother board, a modem, data entry means, prescription writing means, an advertisement, and means for updating the advertisement as so indicated in claim 1. This is supported in the specification on page 2, lines 3-11. The device is drawn to a prescription writer for physicians and is generally small enough to be held and carried by the user. Such devices include digital assistants and cellular phones. As such the device includes wireless communication capabilities. Refer to page 4, lines 7-17.

The hand held device includes software that allows the user to interact with the device. As in the case of a physician, the user writes prescriptions directly on the device. In this way, the software facilitates the interaction between the device and the user. Advertising for the hand held device is incorporated directly into the software code that facilitates user/device interaction. That is to say, the advertising is a part of the software code and may be permanently stored on the device. This is supported in the specification on page 5, lines 10-13. Advertisers may purchase visual advertising backgrounds such as a colored splash screen, audible sounds, and the like. Please reference page 5, line 15-27.

Claim 8

The hand held device includes a central processing unit, random access memory, a viewing screen, a mother board, a modem, data entry means, prescription writing means, an advertisement, and means for updating the advertisement as so indicated in claim 8. This is supported in the specification on page 2, lines 3-11. Advertising for the hand held device is incorporated directly into the software code that facilitates user/device interaction. That is to say, the advertising is a part of the software code and may be permanently stored on the device. This is supported in the specification on page 5, lines 10-13. The device includes a signal converter (see page 4, line 21), printing means and updating means (see page 3, lines 3-4).

Claim 12

A method of advertising includes providing a hand-held electronic device (see page 1, lines 21-25), providing at least one electronic banner advertisement on the device, the advertisement being permanently stored on the device (see page 3, lines 8-10), transmitting prescription information (see page 2, lines 4-7), printing prescriptions and printing advertisement (see page 3, lines 3 and 4).

Claim 16

A computer readable medium contains instructions for controlling a computer system to perform a method, the method comprising providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device (see page 3, lines 6-15).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**ISSUE #1**

The Examiner has rejected Claims 1, 2, 4, 5, 8, 11, 15, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Reilly (U.S. Patent No. 5,740,549) in view of Goetz (U.S. Patent No. 6,421,650) in view of Kolls (U.S. Patent No. 6,601,037). The issue is whether the Claims 1, 2, 4, 5, 8, 11, 15, and 19 are unpatentable over Reilly in view of Goetz in view of Kolls.

ISSUE #2

The Examiner has rejected Claims 7, 12, 16, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Reilly (U.S. Patent No. 5,740,549) in view of Goetz (U.S. Patent No. 6,421,650) in view of Kolls (U.S. Patent No. 6,601,037) in view of Lupi (U.S. Patent No. 5,755,462). The issue is whether the Claims 7, 12, 16, and 18 are unpatentable over Reilly in view of Goetz in view of Kolls in view of Lupi.

GROUPING OF CLAIMS

Claims 1, 2, 4-8, 11, 12, 15, 16, 18, and 19 stand or fall together.

VII. ARGUMENT

(i.) - §103(a) REJECTION OF CLAIMS 1-3, 5-8, 10, 12-15, 18, 20-23 and 26-28

The Examiner has rejected Claims 1, 2, 4, 5, 8, 11, 15, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Reilly (U.S. Patent No. 5,740,549) in view of Goetz (U.S. Patent No. 6,421,650) in view of Kolls (U.S. Patent No. 6,601,037). At issue is whether the claims are unpatentable over the cited references.

Appellant respectfully notes that in order to establish a prima facie case of obviousness, three basic criteria must be met. Please reference MPEP 706.02(j). First, there must be some motivation to combine the reference teachings. This motivation must be in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Secondly, there must be a reasonable expectation of success. The combination of the teachings cannot destroy the intended function thereof. Finally, the references must teach or suggest all of the claimed limitations of the invention. Appellant contends that the Examiner has not properly established a prima facie case of obviousness because the criteria for doing so have not been met.

With reference to Claims 1, 2, 4, 5, 8, 11, 15, and 19, the Examiner states in his final office action dated May 18, 2004 that Reilly discloses a central processing unit, random access memory, a motherboard, a modem, data entry means, and at least one advertisement. The Examiner also states that Reilly discloses that the advertisement is chosen from the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, splash screen displayed in between a prescribing session, audio, audio visual, printable discount coupons, and printable company logo and updating means for updating the at least one advertisement. Additionally, the Examiner asserts that Reilly discloses updating the advertising via updating the software. It is noted here that the Examiner expressly states that Reilly does not disclose the above items in conjunction with a hand held device. Separately, the Examiner states that the reference to Goetz does disclose a hand held device and transmitting prescription information. The Examiner further states that Kolls discloses audio, visual, the combination of the two, and coupon printing. The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goetz's prescription information and utilization of a PDA, and Kolls advertisement features to Reilly's remote computer, which locally stores advertising that gets updated, to arrive at the claimed invention.

There are several reasons why the position held by the Examiner in rejecting the above grouping of claims is improper under §103(a). The Examiner asserts that it would have been obvious to a person of ordinary skill in the art to combine the teachings of Reilly, Goetz, and Kolls to arrive at the subject invention. However, there is no motivation in the references cited to make such a combination as Goetz makes no reference to advertising in any form and neither Reilly nor Kolls discusses a prescription writing device having at least one advertisement permanently stored in the software. To hold the position that it is simply possible to combine the cited references to arrive at the invention of the subject application without motivation is not sufficient to establish a prima facie case of obviousness, *In re Mills*, 916 F.2d 680 16 USPQ2d 1430. Appellant contends that it is not desirable to combine the manner in which Reilly and Kolls disclose advertising with the hand held device of Goetz. The amount of data being downloaded as suggested by Reilly and Kolls would quickly overflow the data storage capability of the hardware of Goetz as it is vastly smaller than the data storage capabilities of the hardware for Reilly and Kolls. In fact, the hardware of Goetz could simply not store all the data that is downloaded to Reilly and Kolls. The advertising scheme would not function properly. The 103(a) rejection is further improper because the combination of the cited references does not teach a hand held device that includes permanently stored advertisements as part of the software code used to operate the hand held device, as disclosed in the subject application. Nowhere in the references do the patents teach, mention, or allude to permanent storage of the advertisements as part of the software code of a prescription writing device. In contrast, Reilly and Kolls discuss frequent downloads of advertising files based on a given user profile that are read by a module of the personal computer software. That is to say, the advertising displayed on the screen of the computing devices of either Reilly or Kolls is not permanently contained within the software code. A person of ordinary skill in the art would recognize these files as being temporarily stored in the memory of the computing device.

Appellant now draws attention to the present invention, which utilizes a hand held device that can be easily carried by a physician for the purpose of writing prescriptions as discussed in

the subject application on page 4, lines 7-14. The hand held device includes a processing unit, memory, a screen, data entry means, and a modem. The hand held device also includes software that functions in conjunction with the above described hardware and which controls the prescription writing aspects of the device. As emphasized on page 4, line 26, the software is added before the device is constructed. One purpose for doing this is to maximize the use of the hardware as memory capacity of the device is limited due to its size and mobility. A person of ordinary skill in the art would know of the inherent limitations of such a hand held device or Personal Digital Assistant, herein referred to as PDA. These mobile hand-held devices typically incorporate less powerful central processing units, herein referred to as CPUs. Accordingly, memory storage is also significantly limited, especially as compared to the memory storage capacity of a personal computer (referred to as a PC). Such components may also function at a slower speed. Advertisements displayed on the device of the subject application are thus permanently stored in the software code to make best use of the hardware. Please refer to page 5, lines 10-13. This is to be sharply contrasted with the scheme of continuously downloading advertising files as discussed in both Reilly and Kolls. PCs have substantially more powerful microprocessors and greater dynamic and static memory storage capacity. While the hand held device may function to connect to a remote source via wireless communications and a modem, refer to page 4, lines 16-21, it contains a limited amount of data storage capabilities as the device is designed for a more memory-efficient application. Typically, hand held devices, digital assistants, cellular phones, and the like contain a small amount of working memory especially as compared to personal computers and computer servers that include as much dynamic memory, volatile RAM for example, as the hand held device includes static memory storage. Clearly, there is a significant difference between the computing power of a hand held device and that of PC. A person of ordinary skill in the art would know of the distinction in the capabilities of the two types of devices. While advances in computer technology continue to change quickly, giving greater computing power to increasingly smaller devices, at the time of this appeal brief there exists a distinct and notable difference in the capabilities of a hand held device and PC.

Prior art does not contain a reason to combine the reference teachings

The first reason why a prima facie case of obviousness has not been properly established is that there is no motivation or suggestion to combine the teaching of the cited references. The teaching of both Reilly and Kolls make no mention of a prescription writing device. Rather Reilly teaches an advertising and information distribution system, (col. 1, lines 4-10) that disseminates news and advertisements to a set of subscribers. Kolls discusses an advertising and payment system for eliminating processing transaction fees incurred by a merchant, (col. 1, lines 22-25). Both references teach a computerized network including server based hardware and a plurality of remotely located computerized workstations. (See Reilly col. 2, line 61 through col. 3, line 5 and Kolls col. 1, lines 30-33). The references teach advertising over a wide area communication network by downloading files on a continuously ongoing basis. The advertising itself is intended to reach a large group of end-users. In contrast, the advertising of the subject invention relates to a single user, a physician, who views a splash screen advertisement, permanently stored in the software of a prescription writing device. The Examiner asserts that it would have been obvious to combine the teaching of Goetz with Reilly and Kolls. However, Goetz does not mention advertising on a physician component or a prescription writing device. Thus, there is nothing in Goetz that discusses advertising on a prescription writing device and there is no mention of a prescription writing device in the disclosure of Reilly and Kolls. Inasmuch, appellant contends that there is no explicit suggestion in the cited references to combine the teachings to arrive at the invention of the subject application.

The Examiner is left with an assumption that there is an implicit suggestion in the knowledge generally available to one of ordinary skill in the art to combine the teaching of the cited references. The Examiner so states in the final office action, page 4, that it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Goetz's prescription writing device and utilization of a PDA, and Kolls advertisement features, to

Reilly's remote computer with locally stored advertising that gets updates. Appellant respectively notes MPEP 2143.01, which states "The mere fact that references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggested the desirability of the combination (*In re Mills*, 916 F.2d 680, 16 USPQ2d 1430). Such a combination may relate to the nature of the problem being solved. Appellant notes that the problems being solved by the cited references are very different from each other. First, Goetz does not attempt to address the problem of advertising in any manner. Rather, Goetz addresses the concern of better control implementation of medical therapies, (col. 2, lines 11-21). Goetz includes a system of component devices that provides proper information to the patient, (col. 2, lines 59-63). Goetz makes no attempt to include advertising in the prescription writing device. Reilly attempts to address the issue of disseminating information and advertising to subscriber's computers where the information and advertisements are automatically displayed when the computer meets some idleness criteria. (See col. 2, lines 28-33). Kolls pertains to a payment system, which includes interactive advertising displays. Kolls relates to eliminating processing transaction fees incurred by a merchant as discussed above. Still, the way that the advertisements in Reilly and Kolls are implemented does not suggest the desirability of combining that advertising scheme with the hardware of Goetz. Specifically, Reilly discloses downloading advertisements, which are typically fixed images used by display scripts, and storing them in a local database on the remote device. The image files are typically compressed, downloaded usually during the night because of their size, and temporarily stored on the hard drive. (See col. 8, lines 45-67 and col. 7, lines 21-28). In fact, the hardware of Goetz could not function in the same manner as the hardware of Reilly by processing large amounts of data. Similarly, Kolls discusses advertising files that are downloaded globally via a network that interconnects a universal server to a plurality of vending machines. (See col. 34, lines 10-20 and col. 23, lines 25-34). The advertisements can be selected for display on the remote device either randomly or in accordance with a customer profile. (See col. 33, lines 46-49). Furthermore, Kolls never mentions an advertisement that is permanently stored in the software of the remote device but rather emphasizes that the advertisements are stored in a database as described in col. 39, lines

43-49. This actually teaches away from the claimed invention of the subject application, which addresses advertising to a single individual, namely a physician, on a prescription writing device. The advertisements are not downloaded as suggested by Reilly and Kolls. The advertising on Reilly and Kolls is very different from the permanently stored splash screen on the prescription writing device incorporated directly into the software of the device. Appellant notes the distinctiveness between downloading advertising files and updating software that permanently stores a splash screen and/or an audible signal. Appellant contends the teaching of Reilly and Kolls does not suggest the desirability of combining with Goetz to arrive at the subject invention, as the types of problems being solved, and manner in which the solutions are implemented, do not provide a basis for an implicit suggestion to combine the cited references to arrive at the invention of the subject application.

**The proposed modification cannot render the prior art unsatisfactory
for its intended purpose**

The MPEP section 2143.01 further states that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. Appellant now draws attention to the hardware devices of Reilly. Reilly discusses the two types of computer based systems utilized in the patent. The first is an information server. The information server includes a central processing unit, primary memory (i.e., fast random access memory) and secondary memory (typically disk storage), a user interface, an Internet interface for communication with the client computers via the Internet, and one or more news wire interfaces for receiving news feeds from information transmission services such as the AP news feed, the DOW news feed and various sports news feeds. (See col. 4, lines 23-28). The second system is a subscriber's workstation, which also includes a central processing unit,

primary memory (i.e., fast random access memory) and secondary memory (typically disk storage), a user interface, an Internet interface for communication with the client computers via the Internet. (See col. 6, lines 25-31). Both of said systems are high end, high computing capacity computers that include large amounts of data storage capabilities, i.e. a hard drive. This is reinforced by the fact that the workstation's secondary memory stores a local information database as stated in col. 6, lines 46-56. These systems are directly connected to the Internet for the purpose of downloading large amounts of data, which includes news text (relatively small-sized files) and larger advertising image files (col. 8, lines 45-67). These high end systems are designed with substantial computing power so as to not slow down the performance of the computer while the user is logged on. That is to say, the computer systems contain large amounts of fast RAM and static hard drive storage space. Typically, such systems also include fast microprocessors. These components are needed to process the large amounts of data being transmitted over the network connection. Appellant contends that the device of Goetz could not function in the manner described above. In other words, it is not possible for the prescription writing device of Goetz to download volumes of data from the Internet and store the data in non-volatile memory as Goetz neither has the data storage capacity nor the high end processing power as that of a PC. Goetz discloses that the physician component is preferably a PDA. Preferably the PDA is a Palm PC (col. 9, lines 46-48). The Palm PC functions like a PDA, but also includes e-mail access with attachments, and the ability to view Web content offline. Palm PCs enable users to carry their vital desktop information, i.e. calendar, contacts, tasks, inbox, and Internet and intranet information, in one convenient, palm-sized design with easy-to-use one-handed operation. This device currently includes a minimum of 2 Megabytes of RAM and 4 Megabytes of ROM to store the Windows CE software and applications as compared to a standard PC having 256 Megabytes or more of RAM. A person of ordinary skill in the art would clearly understand that the computing power of the PDA – Palm PC device is substantially less as compared to that of the personal computers described above. Furthermore, the data storage capabilities of the PDA – Palm PC device are far less than the personal computers of Reilly. The PDA may include storage of Megabytes of data as compared to the PC, which typically includes

Gigabytes of data storage; orders of magnitude greater. One could not expect the PDA or Palm PC of Goetz to function like the computing devices of the cited references that receive large volumes of data and store the data for display responsive to a user profile or interactive advertisement display screen. Hence, there is nothing desirable about combining the downloading of large volumes of data to a PDA.

All claim limitations must be taught or suggested

Finally, appellant respectfully contends that the Examiner has not established a prima facie case of obviousness because all of the claim limitations of the claimed invention are not taught or suggested by the prior art. Appellant notes that all claim limitations must be considered. Claim 1 requires a central processing unit, random accessible memory, a viewing screen, a motherboard, a modem, data entry means, prescription writing means, at least one advertisement, the at least one advertisement being viewable on the viewing screen, the at least one advertisement being permanently stored on the device, the at least one advertisement being chosen from the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, splash screen displayed in between a prescribing session, audio, audio visual, printable discount coupons, and printable company logo; and, updating means for updating the at least one advertisement. Claim 2 requires the steps of providing a hand-held electronic device having a central processing unit, random accessible memory, a mother board, a viewing screen, and data entry means; providing software for operating the device; providing means for advertising, the advertising being viewable on the viewing screen, the advertising being permanently stored on the device; and, updating the advertising via updating the software. Claims 1 and 2 are listed above merely as an example of an apparatus and a method claim. Appellant notes the underlined portions of the independent claims, which specify that the advertisement is permanently stored on the device. The specification supports this on page 5, lines 10-13, which states “The advertising is permanently

stored on the hand-held device, preferably as part of the software code.” The specification of the subject application further delineates permanently stored by stating “the advertising is not saved in a temporary file or directory.” One of the reasons for permanently storing the advertising on the device is to conserve the limited capacity of data storage of the hand held device. Inherently, hand held devices such as a PDA or other mobile prescription writing device contain relatively small amounts of dynamic and static memory. For this reason, it is preferred that the advertisement is part of the software code. Thus, the application states on page 4, line 26, “The advertising can be added to the software of the device before the device is constructed.” This process can also be done after the device is constructed. As the specification states on page 6, lines 21-23, “The advertising may also be periodically updated on the device, via modem or any other method capable of updating the information.” “The updating will be part of a software code, and updating will update the software code.” The Examiner asserts that Reilly discloses this limitation of the claim as alleged by the specification at column 3, lines 5 through 15. For convenience, the section is listed below: *An information administrator in each workstation establishes communication with the information server from time to time so as to update the information items and advertisements stored in local memory with at least a subset of the information items and advertisements stored by the information server. An information display controller in each workstation displays on the workstation's display device at least a subset of the information items and advertisements stored in local memory when the workstation meets predefined idleness criteria.* This reference to Reilly does not mention the updating of the software code used to operate the computing device. Rather, it pertains to the downloaded news stories and advertisements. But, the advertisements are stored in a local information database as discussed in Reilly, (col. 6, lines 46-55). A person of ordinary skill in the art would understand the difference between permanently stored software code and files temporary stored in a database. This is further supported by Reilly in col. 15, lines 2-5, which states, “The application server calls ... to collect all the information that needs to be sent to the client computer ... along with instructions on what items, if any, should be deleted from the client computer's local information database.” This reference in Reilly clearly indicates that downloaded advertising

files are temporarily stored, i.e. not permanent stored, and may as such be deleted. In other words, the temporarily stored advertising files can be deleted without altering the software code that operates the PC. It is widely known in the art to download files for use by a base program, of which the downloaded files can be readily deleted when the base program is done running that particular application. Reilly and Kolls attest to this process. But, this process is not what is happening inside the prescription writing device of the claimed invention. The subject invention permanently stores the advertising data. Neither Reilly or Kolls, or the combination thereof, teaches an advertisement that is permanently stored in the code of a software program. Therefore, all of the claim limitations of the subject invention are not taught by the cited references. Hence, a prima facie case of obviousness has not been established.

The cited patent references teaches away from the subject invention

The Examiner has argued that the cited references of Reilly and Kolls teach updating the advertising via updating the software, page 3, paragraph 2. The advertisement of the subject invention is permanently stored in the code of the software that runs the prescription writing device. The advertisement is an integral part of the software code that allows the hand held device to function as a prescription writer. Thus, updating the software code means that the advertisement is also updated. In other words, no additional download is needed to update the advertisement. This is different from the teaching of Reilly. On page 3, paragraph 2 the Examiner makes reference to Reilly in col. 5, lines 45-60 in support of the claim rejections. Reilly states "The information administration management procedures and information viewing procedures in subscribers' computers will need updating and upgrading from time to time." The Examiner additionally references col. 8, lines 5-10. To gain the context of this reference, appellant includes the first portion of the paragraph from which the reference is taken (col. 7, 45-48), which reads "The profiler 206 is actually a set of procedures that define and update the subscriber's user profile 194. Referring to FIG. 4, in the preferred embodiment, the user profile

194 includes ... (col. 8, lines 5-10) timestamps 217a-217c indicating the time of the last updates to the subscriber computer's locally stored set of news stories, advertisements and administrative files (including scripts, images and software modules);” The aforementioned references show that Reilly updates or upgrades the management procedures and/or administrative files. These updates happen from time to time (col. 5, line 51) and are accomplished via a software download (col. 5, line 54). However, what is not precisely known is how these procedures or files relate to the operation of the hardware. What is known is that the advertisements are discrete files, which are separate from the management procedures and/or administrative files, and moreover are separate from the software that controls the hardware. In this manner, Reilly teaches away from the advertisements being permanently embedded into the software code of the prescription writing device. Appellant also notes a pertinent statement by Reilly relating to the problem being solved by the invention of the patent. Col 5, lines 35-37 states, “An important concept associated with the present invention is that constantly varying the presentation of news items and advertisements, through the use of a rotating set of scripts, makes it easier for subscribers to read the news headlines and advertisements being presented.” While the management procedures and/or administrative files are updated from time to time, downloading new advertisements happens continuously. (See col. 8, lines 19-28). Thus, the assertion that Reilly discloses updating the advertising via updating the software is not only an incorrect assertion but Reilly actually teaches away from the feature of permanently storing advertisements into the operating code of a prescription writing device.

For the foregoing reasons, it is respectfully submitted that a prima facie case of obviousness has not been properly established by the Examiner. Inasmuch, appellant asserts that the rejection of the claims is erroneous and believes the claims remaining distinguish over the cited references. Allowance of the claims is requested.

Please deduct \$250.00 for the fee for filing a brief in support of an appeal under 37 CFR §41.20(b)(2) from Deposit Account No. 50-1210. Appellant claims small entity status under 37 CFR §1.9 and §1.27.

Respectfully submitted,

BROUSE McDOWELL

July 11, 2005
Date

A handwritten signature in black ink, appearing to read 'D. Thomson', written over a horizontal line.

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VIII. CLAIMS APPENDIX (37 C.F.R. 1.192(c)(9))

CLEAN COPY OF THE CLAIMS

1. A hand-held electronic device comprising:
a central processing unit;
random accessible memory;
a viewing screen;
a motherboard;
a modem;
data entry means;
prescription writing means;
at least one advertisement, the at least one advertisement being viewable on the viewing screen, the at least one advertisement being permanently stored on the device, the at least one advertisement being chosen from the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, splash screen displayed in between a prescribing session, audio, audio visual, printable discount coupons, and printable company logo; and,
updating means for updating the at least one advertisement.
2. (Once Amended) A method for providing advertising, the method comprising the steps of:
providing a hand-held electronic device having a central processing unit, random accessible memory, a mother board, a viewing screen, and data entry means;
providing software for operating the device; and,
providing means for advertising, the advertising being viewable on the viewing screen, the advertising being permanently stored on the device; and,

updating the advertising via updating the software.

3. CANCELLED

4. (Once Amended) The method of claim 2, wherein providing a hand-held electronic device having a central processing unit, random accessible memory, a mother board, a viewing screen, and data entry means comprises the step of:

providing a hand-held electronic device having a central processing unit, random accessible memory, a motherboard, a viewing screen, a signal converter, and data entry means.

5. (Once Amended in Amendment B) The method of claim 4, wherein providing means for advertising, the advertising being viewable on the viewing screen, the advertising being permanently stored on the device comprises the steps of:

providing a software code;

providing means for advertising, the advertising being viewable on the viewing screen, the advertising being permanently stored on the device as part of the software code, the advertising being chosen from one or more of the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, splash screen displayed in between a prescribing session, audio, audio visual, printable discount coupons, and printable company logo.

6. The method of claim 4, wherein the method further comprises the step of: updating the advertising via the signal converter.

7. The method of claim 4, wherein the method further comprises the step of: printing a prescription with the advertising on the prescription.

8. (Once Amended) A hand-held electronic device having a central processing unit, random accessible memory, a mother board, a viewing screen, data entry means, the device comprising:

at least one advertisement, the at least one advertisement being viewable on the viewing screen, the at least one advertisement being permanently stored on the device;

a signal converter;

printing means; and,

updating means for updating the at least one advertisement.

9. CANCELLED

10. CANCELLED

11. (Once Amended) The device of claim 8, wherein the at least one advertisement is chosen from one or more of the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, splash screen displayed in between a prescribing session, audio, audio visual, printable discount coupons, and printable company logo.

12. (Once Amended) A method for advertising, the method comprising the steps of:
providing a hand-held electronic device; and,
providing at least one electronic banner advertisement on the device, the advertisement being permanently stored on the device;

transmitting prescription information;

printing prescriptions; and,

printing the at least one advertisement on the prescription.

13. CANCELLED

14. CANCELLED

15. The method of claim 12, wherein providing at least one electronic banner advertisement on the device, the advertisement being permanently stored on the device comprises the step of:

providing at least one electronic banner advertisement on the device, the advertisement being permanently stored on the device, the at least one advertisement is chosen from one or more of the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, splash screen displayed in between a prescribing session, audio, audio visual, printable discount coupons, and printable company logo.

16. (Once Amended) A computer readable medium containing instructions for controlling a computer system to perform a method, the method comprising:

providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device; and, updating the at least one advertisement.

17. CANCELLED

18. (Once Amended) The computer readable medium of claim 16, wherein providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device, comprises:

providing at least one electronic banner advertisement for an electronic hand-held device, the at least one advertisement being permanently stored on the electronic hand-held device, the device having a central processing unit, random accessible memory, a mother board, a signal converter, and data entry means.

19. The computer readable medium of claim 18, wherein the at least one advertisement is chosen from the group comprising color highlighting of associated product, color background graphics identifying the product, video, animation, splash screen displayed in between a prescribing session, audio, audio visual, printable discount coupons, and printable company logo.

IX. EVIDENCE APPENDIX

No evidence was submitted pursuant to §§ 1.130, 1.131, or 1.132, nor was there any evidence submitted during the prosecution of this case. No evidence was entered by the examiner or relied upon by the appellant.

X. RELATED PROCEEDINGS APPENDIX

There are no related appeals, decisions, or proceedings.